

KCC 4803
K-C 16,436
PATENT

REMARKS

Applicants have thoroughly considered the Examiner's remarks and the application has been amended in light thereof. Claims 24-27, 33, 39 and 41-44 are presented in the application for further examination. Claim 33 has been amended by this Amendment B. Claims 41-44 have been added by this Amendment B. Reconsideration of the application claims as amended and in view of the following remarks is respectfully requested.

Before proceeding with a response to the rejections based on 35 U.S.C. §103, it is noted that claims 16, 21, 22 and 38 have been cancelled and replaced by independent claims 41-44, respectively. Claims 41-44 present the subject matter of the cancelled claims in independent form. Thus, claims 41-44 raise no new issues and are subject to continued examination.

Before addressing each particular rejection, Applicants would like to generally address the Examiner's prior action. In particular, Applicants submit that claims 24-27, 33, 39 and 41-44 are patentable over the prior art so that the rejection should be withdrawn. The essence of the Examiner's position relates to the argument that it would be obvious to apply the teachings of Direct Marketing which relate to the sale of customized toilet paper with certain options, to the totally unrelated system and method of Forseth relating to customized food selection, and to the totally unrelated method and system of Wilmott relating to customized cosmetic and pharmaceutical formulations. Thus, the three references primarily cited by the Examiner are a mere aggregation based on hindsight analysis of the claims. The Examiner has failed to cite any references which would suggest the application of the teachings of Forseth and Wilmott to the Direct Marketing reference. No reference suggests the applicability of Forseth or Wilmott to absorbent paper products or custom facial tissues as recited by the

KCC 4803
K-C 16,436
PATENT

claims. Without such a teaching, the obviousness rejection falls short and must be withdrawn. "[T]he question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination." Lindemann Maschinenfabrick GMBH v. American Hoist and Derrick Company, 730 F.2d 1452, 1462; 221 U.S.P.Q. 481, 488 (Fed. Cir. 1984). As has been shown, the non-analogous teachings of the prior art relate to different fields of endeavor and are directed to entirely different problems. Therefore, nothing in the cited references suggests their combination. Indeed, the Examiner failed to cite any basis whatsoever for combining these references. In fact, the Examiner's rejection provides a textbook example of impermissible hindsight analysis -- the Examiner used the invention as defined by the claims as a guide to pick and choose non-analogous references in order to reject the claims. See In re Oetiker, 977 F.2d at 1447; 24 U.S.P.Q.2d at 1446 (Fed. Cir. 1992) ("There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge can not come from the applicant's invention itself.").

Furthermore, Direct Marketing is merely a suggestion as to the offering of customized toilet paper with certain options and does not relate to a method of supplying absorbent paper products in the context of a system including a production machine configured to produce custom absorbent paper products according to pre-selected options. In other words, the Examiner has failed to cite any references which illustrate a custom absorbent paper product production machine. Forseth and/or Wilmott cannot be modified to provide a custom absorbent paper product production machine. Direct marketing fails to teach a custom absorbent paper product production machine. Thus, the

KCC 4803
K-C 16,436
PATENT

combination of references does not read on or otherwise make the claims obvious because the claims recites a custom absorbent paper product production machine.

The following remarks will follow the sequence of the Office action.

Claims 1-10, 36, 11-15, 37, 28-32, 40 and 34-35 stand rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. These claims have been cancelled.

Claims 1, 2, 5-7, 10-13, 15-21, 23-29 and 31-40 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Direct Marketing in view of Forseth. This rejection is applicable to claims 24-27, 33, 39, 41, 42 and 44.

Regarding claim 24, the Examiner argues that Direct Marketing discloses and teaches a method and system in which a supplier provides a consumer an absorbent paper product. The Examiner further argues that Forseth discloses and teaches a method and system for identifying first and second features of the absorbent product. Applicants disagree and submit that there is no basis for combining the references as suggested by the Examiner. Direct Marketing relates to a manual system for providing products. In contrast, Forseth discloses a customized food selection, ordering and distribution system and method and is not related to custom facial tissue products, as recited by claim 24. Furthermore, claim 24 specifically recites the step of producing by the production machine the custom facial tissue product. The Examiner has failed to cite any art which illustrates a production machine for a custom facial tissue product. Thus, the combined references do not make claim 24 obvious. Thus, there is no basis for combining the references and the references fall short so that the rejection of claim 24 must be withdrawn.

KCC 4803
K-C 16,436
PATENT

Regarding claims 38 and 39 (now claims 44 and 39, respectively), the Examiner argues that Forseth teaches a method wherein the first feature and second feature are selected from the group consisting of product count, product style, product color, product scent, product graphic design, product packaging style, product packaging color and product packaging graphic design. Claim 39 is patentable based on its dependency from claim 24. Furthermore, Forseth does not suggest presenting these six options to the consumer so that the consumer can select two or more of these options. Furthermore, claim 44 recites a production machine configured to produce custom absorbent paper products. As noted above, the Examiner has failed to cite any references which illustrate such machines so that the rejection of claims 39 and 44 must be withdrawn.

Regarding claim 25, the Examiner argues that Forseth teaches a method wherein the communication network is a computer network. Claim 25 recites a computer network for receiving the information relating to the custom facial tissue product. In contrast, Forseth teaches a network relating to food selection. Since the Examiner has failed to cite any references which illustrate the handling of custom facial tissue product information over a network, this rejection must be withdrawn. Claim 25 is also patentable based on its dependency from claim 24.

Regarding claim 26, the Examiner argues that Forseth teaches a method wherein the communications network is a telephony network. Once again, as with claims 24 and 25, Forseth is deficient in that it relates to food selection and not information relating to custom facial tissue products. Thus, the rejection regarding claim 26 must be withdrawn.

As noted above, claim 33 has been rewritten in independent form. Regarding claim 33, the Examiner argues that Forseth

KCC 4803
K-C 16,436
PATENT

teaches a method wherein providing includes providing the customer absorbent paper product only to said consumer. However, it appears that the Examiner has missed the point with regard to claim 33 which recites identifying a plurality of different graphic designs for packaging and further recites receiving identification of selected designs and a purchase order. There is nothing in Forseth or any of the other references cited which discuss the identification and implementation of a graphic design of the packaging in the context of a purchase order, as recited by claim 33. Thus, the Examiner must withdraw the rejection of claim 33.

Claim 22 stands rejected under 35 U.S.C. §103 as being unpatentable over Direct Marketing and Forseth and further in view of Wilmott. Claim 22 is now presented in independent form as claim 43. Claim 43 recites a production machine configured to produce a custom absorbent paper product in combination with a fragrancier for applying to the product a scent identified by information from the consumer. In contrast, Wilmott relates to customized cosmetic and pharmaceutical formulations. Thus, the three combined references fail to suggest the combination of a production machine and fragrancier to produce a scented custom absorbent paper product as recited by claim 43 so that the rejection must be withdrawn.

Claims 4, 8 and 30 stand rejected under 35 U.S.C. §103(a) over the combination of Direct Marketing and Phillips et al. These claims have been cancelled.

Regarding claim 21, the Examiner argues that Direct Marketing teaches a system wherein the information includes a graphic design and a printer for printing the graphic design. Claim 21 has been rewritten in independent form and now appears as claim 42. It is noted that claim 42 specifically recites a production machine configured to produce custom absorbent paper

KCC 4803
K-C 16,436
PATENT

products in combination with a printer for printing the graphic design on the absorbent paper product in accordance with the first and second options from the consumer. As the Examiner has failed to cite any art which illustrates a production machine for a custom absorbent paper product, the rejection of claim 42 must be withdrawn.

Regarding claim 16, the Examiner argues that Forseth teaches a method and system wherein the communications network is a computer network or a telephony network. Claim 16 has been rewritten in independent and now appears in the application as claim 41. Claim 41 recites the step of receiving a purchase order from the consumer for the absorbent paper product including the first and second options from the consumer. As the Examiner has failed to cite any prior art which relates to the handling of purchase orders for absorbent paper products, the rejection with regard to claim 41 must be withdrawn.

Although claim 27 was generally rejected as being unpatentable over Direct Marketing in view of Forseth, the Examiner failed to state any specific basis for the rejection. Applicants note that claim 27 depends from claim 26 and is patentable for the reasons noted above with regard to claim 26. In addition, claim 27 recites an automated attendant as the telephone attendant, a feature not taught by any of the references cited by the Examiner. Thus, the rejection applied to claim 27 must be withdrawn.

CONCLUSION

Applicants submit that claims 24-27, 33, 39 and 41-44 are patentable over the prior art so that the rejection may be withdrawn. As noted above, the three references primarily cited by the Examiner are a mere aggregation based on hindsight analysis of the claims. The Examiner has failed to cite any

KCC 4803
K-C 16,436
PATENT

references which would suggest the application of the teachings of Forseth and Wilmott to the Direct Marketing reference. In addition, the Examiner has failed to cite any references which illustrate a custom absorbent paper product production machine. Thus, the references cannot be combined and, in any case, the combination of references does not read on or otherwise make the claims obvious.

It is felt that a full and complete response has been made to the Office action and, as such, places the application in condition for allowance. Such allowance is hereby respectfully requested. If the Examiner feels, for any reason, that a personal interview will expedite the prosecution of this application, he is invited to telephone the undersigned.

Enclosed herewith is a fee transmittal regarding the additional claim fee. If there are any additional charges in this matter, please charge Deposit Account No. 19-1345.

Respectfully submitted,

Frank R Agovino

Frank R. Agovino, Reg No.27,416
SENNIGER, POWERS, LEAVITT & ROEDEL
One Metropolitan Square, 16th Floor
St. Louis, Missouri 63102
(314) 231-5400

FRA/cwa